

REMARKS**Summary of the Office Action**

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Naoki (Japanese Patent Pub. No. JP 2004-001076) (hereinafter “Naoki”).

Claim 6-10, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naoki.

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naoki, and further in view of Fukuyo (European Patent Pub. No. EP 1 338 371) (hereinafter “Fukuyo”).

Summary of the Response to the Office Action

Applicants have newly-amended independent claim 1 to differently describe embodiments of the disclosure of the instant application and/or improve the form of the claim. Accordingly, claims 1-19 remain currently pending with claims 1-15 currently under consideration.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants have newly-amended independent claim 1 to differently describe embodiments of the disclosure of the instant application and/or improve the form of the claim, in response to the Examiner’s comments at pages 2-3 of the Office Action.

In claim 1, Applicants respectfully submit that the position to form at least one row of a second modified region is a position between the first modified region closest to a rear face of the substrate and the rear face just before forming at least one row of a second modified region. Therefore, Applicants respectfully submit that the interpretation stated by the Examiner at page 3 of the instant application does not accurately cover the claimed features of the instant application in these regards.

In claim 7, Applicants respectfully submit that the unit of energy is not required to be included in the claim because of its being calculated as the ratio of the energy of the laser light for forming the first modified regions to the energy of the laser light for forming the second modified region.

In claim 8, Applicants respectfully submit that a reference or a datum is described as the distance between neighboring positions where the light-converging point of the laser light is located when forming neighboring first modified regions.

Accordingly, Applicants respectfully submits that claims 1-15 fully comply with the requirements of 35 U.S.C. § 112, second paragraph. As a result, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Naoki. Claim 6-10, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naoki. Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naoki, and further in view of Fukuyo. Applicants have newly-amended independent claim 1 to differently describe embodiments of the disclosure of the instant

application and/or improve the form of the claim. Applicants respectfully submit that these newly-added features are discussed, for example, at paragraphs [0006], [0062], and [0063] of the specification of the corresponding PCT specification of the instant application. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that the cited references do not disclose certain advantageous features of the claims of the instant application including that when forming a second modified region along the line to cut at a position between the first modified region closest to a rear face of the substrate and the rear face, the fracture extending along the line to cut is generated from the second modified region only to the rear face (i.e., the fracture extending along the line to cut does not reach the front face).

Furthermore, Applicants respectfully submit that the cited references do not disclose, or even suggest, the newly-added features of independent claim 1 of the instant application of “when an expandable film bonded to the rear face is expanded, the fracture extending along the line to cut and generated from the second modified region to the rear face advances from the substrate to the laminate part by way of the first modified regions, whereby the substrate and laminate part can be cut along the line to cut.”

Applicants respectfully submit that the present invention disclosed in the instant application achieves an advantageous effect in that “even when the substrate formed with the laminate part including a plurality of functional devices is thick, this laser processing method can cut the substrate and laminate part with a high precision.” Applicants respectfully submit that these features are discussed, for example, at paragraphs [0006] and [0061] - [0062] in the specification of the corresponding PCT specification.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Noaki does not teach or suggest each feature of independent claim 1 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "'[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Since the prior art does not disclose or suggest any of the combinations recited in Applicants' claims, and if anything appears to teach away from the current claim recitations, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), Applicants submit that such recited combinations would not have been obvious in view of the applied references of record, whether taken alone or combined in the manner suggested by the Examiner in the Office Action.

Furthermore, Applicants respectfully assert that dependent claims 2-15 are allowable at least because of their dependence from independent claim 1, and the reasons discussed previously. With regard to the additionally-applied reference to Fukuyo as to claims 11-13, Applicants respectfully submit that Fukuyo does not cure the deficiencies discussed above of Noaki.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this

response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



Paul A. Fournier
Reg. No. 41,023

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By:

Customer No. 055694

DRINKER BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465